Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK WYATT

Appeal No. 1999-1660
Application No. 08/444,242

HEARD: August 15, 2001

Before HARKCOM, Vice Chief Administrative Patent Judge, and BARRETT and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 33 through 50, which are all of the claims pending in this application.

Appellant's invention relates to a time recording method for assisting in the treatment of sleep disorders. The user automatically records awake time or sleep time by contacting a switch connected to a timer while awake and automatically releasing the switch when the user falls asleep. The timer

records either awake time while the switch is depressed or sleep time while the switch is released. Claims 33 and 40 are illustrative of the claimed invention, and they read as follows:

33. A time recording method for a user to automatically record awake time in a rest position to assist in the treatment of sleeping disorders, said method comprising the steps of:

said user contacting a switch;

said user starting a timer by contacting the switch;

said user maintaining continued user contact with the switch and recording awake time on said timer for so long as the switch is contacted; and

said user removing user contact from the switch when the user falls asleep and thereby stopping the timer.

40. A time recording method for a user to automatically record sleep in a rest position time to assist in the treatment of sleeping disorders, said method comprising the steps of:

said user contacting a switch to control a timer;

said user maintaining continued user contact with said switch and preventing the recordal of time on said timer for so long as said continued contact is maintained;

said user removing user contact from the switch when the user falls asleep and thereby starting the recordal of time on the timer upon falling asleep; and

said user recording sleep time on said timer for so long as the switch is released.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Forbath	4,493,043	Jan. 08, 1985
Miller et al. (Miller)	5,124,960	Jun. 23, 1992

Claims 33 through 37, 40 through 44, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Forbath.

Claims 38, 39, 45, 46, 49, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Forbath.

Reference is made to the Examiner's Answer (Paper No. 20, mailed February 3, 1999) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 19, filed August 20, 1998) for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our

review, we will reverse the obviousness rejections of claims 33 through 50.

All of the claims are directed to methods for recording either awake or sleep time to assist in the treatment of sleeping disorders. Each claim includes in the preamble a reference to recording sleep or awake times and to the use of treating sleeping disorders and also includes a step of removing user contact from a switch "when the user falls asleep."

Forbath is directed to the recording of time periods associated with childbirth such as for labor pain, fetus movement, and breastfeeding. In Forbath, the user contacts a switch, for example at the beginning of a contraction, thereby starting a timer, maintains contact throughout the contraction, and stops the timer by removing contact with the switch at the end of the contraction. Nowhere does Forbath suggest a step of removing contact with a switch as the user falls asleep nor measuring awake or asleep time.

The examiner admits (Final Rejection, page 2) that Forbath fails to disclose "the environment of recording 'sleep' and 'awake' times." The examiner, however, concludes

that recording sleep and awake times are "obvious uses of the disclosed method of the patent in view of a variety of applications of the timer disclosed therein.... The device and associated method may thus be used in any application where time measuring is required with a hand-held timer." The examiner continues (Final Rejection, page 3) that

> use of the device of Forbath is not limited to any particular mental state of the user. Thus, the method may be practiced in the manner disclosed to measure time periods when the person is awake or asleep, or engaged in other activity if switch 14 is actuated previously. The involuntary action of falling asleep of the user subsequent to actuation of the timer switch in Forbath would be within the ordinary and usual range of choices for such an individual. The step of falling asleep as claimed, therefore, cannot serve to provide any patentable subject matter to the otherwise known method.

The examiner has essentially disregarded the claimed method steps and focused solely on the device used to implement the method. Since Forbath discloses a timer with a user-activated switch, the examiner concludes that the remaining claim limitations (i.e., those directed to the method *per se*) would have been obvious.

All of the claims are directed to methods (or processes).

35 U.S.C. § 100(b) states that "'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." Although Forbath's device **may** "be used in any application where time measuring is required with a hand-held timer," the question still remains whether the prior art suggested the particular claimed use or application. The Federal Circuit has held that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-4 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221, USPQ 1125, 1127 (Fed. Cir. 1984). Appellant has basically claimed a new use for an old timer and switch, which can be patentable under the statute if such new use is not disclosed or suggested by the prior art.

The entire disclosure of Forbath is directed to activities associated with childbirth. Nowhere does Forbath suggest that the device and method may be used with any

activities other than those explicitly described. Further, in Forbath, the user of the timer must consciously press the switch to activate the timer, continue pressing the switch to maintain the on-state of the timer, and consciously release the switch to stop the timer at the end of the activity being timed. For claims 40, 48, and 50, Forbath is diametrically opposed to the claimed invention in that Forbath times an activity during which a user is very much awake, whereas the claims recite tracking the time during which the user is asleep. Claims 33, 47, and 49, as well as claims 40, 48, and 50, recite that the user releases the switch when he falls asleep, whereas Forbath requires the user to be awake to release the switch. Thus, Forbath's disclosure again is contrary to the claimed invention.

Further, the examiner states (Answer, page 4) that

> the use of a timer to measure the time of a specific event has no patentable significance with respect to the event itself, unless there exists some physical connection between the event environment and the timer. In applicant's case, there exists no connection or physical method step between the timer and the sleep environment.... The terms "awake time" "and sleep time" add nothing to the claims other than the user's mental state.

In the present claims, there is a physical connection between sleeping (the examiner's "event environment") and the timer. The user must fall asleep to release the switch and, thus, activate or deactivate the timer. As to a connection or physical method step between the timer and the sleep time, each claim recites a method step of the user removing contact from the switch (and thus activating or deactivating the timer) "when the user falls asleep." In the face of such a claim limitation, the examiner's assertion that there is no physical method step between the timer and the sleep time is incomprehensible. Last, the terms "awake time" and "sleep time" do not merely add the user's mental state, as they describe what the timer is to monitor.

Forbath clearly does not disclose using a timer and switch in measuring sleep or awake time nor the step of releasing the switch when a user falls asleep. Nor does Forbath suggest such use or method step. For a rejection under 35 U.S.C. § 103, the examiner is required to provide a reason from some teaching, suggestion or implication in the prior art as a whole, or knowledge generally available to one of ordinary skill in the art, why one having ordinary skill in

the pertinent art would have been led to modify the prior art to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *Note In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239
(Fed. Cir. 1995), citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983). The examiner has provided no evidence or convincing line of reasoning as to why the skilled artisan would have used the device and method of Forbath for timing awake or sleep time such that the switch is released when the user falls asleep. Therefore, the examiner has failed to establish a *prima facie* case of obviousness. Accordingly, we

cannot sustain the rejection of claims 33 through 37, 40 through 44, 47 and 48 over Forbath.

For claims 38, 39, 45, 46, 49, and 50, the examiner relies on Miller in view of the teachings of Forbath. Miller, discloses the placement of a switch and timer on a user's finger and arm, respectively. Miller, however, is directed to timing events, such as during athletic activities, where the user must be able to concentrate on such activity and is, thus, very much awake. Miller does not suggest using the timer for measuring sleep or awake time. Additionally, the user in Miller activates a timer by depressing and releasing a switch. The user then stops the timer at the conclusion of the activity by again depressing and releasing the switch. Both activation and deactivation are accomplished by consciously pressing the switch. Miller's method differs significantly from the claimed methods of activating and deactivating a timer by releasing contact with a switch when the user falls asleep. Consequently, Miller cannot cure the above-noted deficiency of Forbath. Therefore, we cannot sustain the rejection of claims 38, 39, 45, 46, 49, and 50 over Miller and Forbath.

CONCLUSION

The decision of the examiner rejecting claims 33 through 50 under 35 U.S.C. § 103 is reversed.

REVERSED

GARY V. HARKCOM Vice Chief Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

AG/RWK

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